

## **REMARKS/ARGUMENTS**

### **Description of amendments**

Claims 3-7 are now pending and under examination. Applicant has amended claim 7 and cancelled claims 8-12. No new matter has been added.

The amendment to claim 7 is supported by the application as originally filed (see, for example, page 6, lines 8-14).

### **Rejection under 35 U.S.C. §102**

Claims 3, 4, 6-9, 11, and 12 were rejected under 35 U.S.C. §102(b) as being anticipated by Avers (U.S. Patent 5,788,035). The cancellation of claims 8-12 renders the rejection of claims 8, 9, 11, and 12 moot. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of the rejection with respect to claims 3, 4, 6 and 7.

Independent claim 7, as amended, has patentable features that are not disclosed by Avers. For example, claim 7 calls for two separator plates, disposed between two adjacent friction plates, that are "completely separate from each other and can freely move...."

This feature of claim 7 is clearly directed to the embodiment of the present invention where the two separator plates are not "adhered and fixed with each other with a thin member interposed therebetween" (lines 8-14 on page 6 of the original specification). As stated at lines 8-14 on page 6 of the original

specification, the two "separately" disposed separator plates can be one of two designs, i.e. they <sup>(1)</sup> not only can completely separate from each other and can freely move but also, <sup>(2)</sup> even when the two mutually-adjacent separator plates are adhered and fixed with each other with a thin member interposed therebetween, can slightly move in an axial direction owing to the elasticity of the thin member and/or an adhesive. This language of the original specification clearly shows that Applicant meant that, when they are "completely separate from each other and can freely move," the two separators are not "adhered and fixed with each other with a thin member interposed therebetween." Accordingly, Claim 7 must be interpreted in accordance with Applicant's definition, i.e., the at least two separator plates of claim 7, which are "completely separate from each other and can freely move," are not "adhered and fixed with each other with a thin member interposed therebetween." If the applicant has acted as his own lexicographer, the applicant's definition applies. *See, e.g., York Prods., Inc. v. Central Tractor Farm & Family Ctr.*, 99 F.3d 1568, 40 USPQ2d 1619 (Fed. Cir. 1996).

In Avers, the two separator plates (24a, 24b) are bonded to a layer (24c) of viscous and elastic material (column 4, lines 27-34). In other words, the two separator plates (24a, 24b) of Avers are adhered and fixed with each other with an elastic thin member interposed therebetween. Therefore, as defined by Applicant in the original specification, the two separator plates (24a, 24b) of Avers cannot be "completely separate from each other and can freely move." As a

result, Avers cannot anticipate claim 7, as well as claims 3, 4, and 6, which depend from claim 7.

The wet multiple clutch of the claimed invention has various advantages over the prior art. In the wet multiple clutch of claim 7, for example, the at least two groove-free separator plates, which are arranged between two adjacent friction plates, are disposed completely separately from each other and can freely move independently of each other. This design makes the separator plates more flexible. The reduced rigidity makes it possible to avoid occurrence of an uneven contact between the separator plates and the corresponding friction plates. As a result, occurrence of heat spots are reduced (see the specification at page 4, lines 22 to page 6, line 6).

Rejection under 35 U.S.C. §103(a)

Claims 5 and 10 were rejected under 35 U.S.C. §103(a) as being unpatentable over Avers in view of JP 40-5231443 (JP-5-231443). The cancellation of claims 8-12 renders the rejection of claim 10 moot. Regarding the rejection of claim 5, as discussed above, Avers does not teach or suggest certain limitations of claim 7. In addition, the Examiner did not allege that JP 40-5231443 teaches or suggests these limitations. Therefore, the Examiner has not established that the cited references teach or suggest every element of claim 7 and, thus, every element of 5. Accordingly, claim 5 is not obvious in view of the cited references.

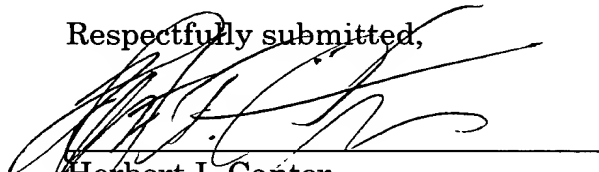
Application No. 09/940,519  
Reply dated November 3, 2003  
Response to Office Action dated July 1, 2003

In light of the foregoing remarks, this application is considered to be in condition for allowance, and early passage of this case to issue is respectfully requested. If there are any questions regarding this amendment or the application in general, a telephone call to the undersigned would be appreciated since this should expedite the prosecution of the application for all concerned.

If necessary to effect a timely response, this paper should be considered as a petition for an Extension of Time sufficient to effect a timely response. Please charge any deficiency in fees or credit any overpayments to Deposit Account No. 05-1323 (CAM #: 038769.50357US).

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Respectfully submitted,



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